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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,400	11/04/2003	Peter A. Quigley	FPY-048C3	5827

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GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
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EXCHANGE PLACE
BOSTON, MA 02109-2881

EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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03/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/700,400	Applicant(s) QUIGLEY ET AL.	
	Examiner Elizabeth M. Cole	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-67 of U.S. Patent No. 5,921,285 in view of Charboneau, U.S. Patent No. 5,551,484. US '285 claims a spoolable composite tube comprising a substantially fluid impervious inner liner, a first composite layer enclosing said liner and formed of fiber and matrix, said first composite layer having a first fiber extending helically and have a second clockwise extending fiber and having a third counter clockwise extending fiber, such that said first fiber is interwoven with a least one of said second fiber and said third fiber, and a first energy conductor embedded in and extending along the length of said spoolable composite tube. US '285 differs from the claimed invention because it does not disclose that the tubing comprises a sensor. Charboneau discloses a lining for pipelines which may include an optical fiber which is in the liner for purposes of monitoring stress or for communication, and which further

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comprises a capacitance leak detection circuit in the liner. Charboneau teaches that the optical fibers can be connected to a stresses detector to monitor the liner when it is installed in a pipeline. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated optical fibers for the purpose of monitoring stresses in the tubular member of US '285, motivated by the expectation that this would enable pipelines which employed the liners to be monitored for possible problems.

3. Claims 1-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,888,601 in view of Charboneau, U.S. Patent No. 5,551,484. US '601 claims an axially extending tubular composite member having a plurality of plies comprising at least one interior ply having at least one biaxial fiber component with a matrix material, at least one intermediate ply having at least one axially extending fiber component disposed within said matrix material and at least one external ply having a woven fiber component with threads oriented parallel to said longitudinal axis and threads oriented transverse to said longitudinal axis, (claim 1), wherein said fiber component of said intermediate ply includes a first axial fiber and second and third fibers each oriented diagonally relative to said first fiber, so that said first, second and third fibers together form a triaxial fiber component. US '484 does not claim a substantially impervious pressure barrier layer, or the claimed energy conductor and sensor. Charboneau discloses a lining for pipelines which may include an optical fiber which is in the liner for purposes of monitoring stress or for communication, and which further comprises a capacitance leak detection circuit

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in the liner. Charboneau further teaches that such linings can comprise an impervious barrier layer. Charboneau teaches that the optical fibers can be connected to a stresses detector to monitor the liner when it is installed in a pipeline. See col. 4, lines 1-61. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated optical fibers for the purpose of monitoring stresses in the tubular member of US '285, motivated by the expectation that this would enable pipelines which employed the liners to be monitored for possible problems.

4. Claims 1-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-30 of U.S. Patent No. 6,357,485 in view of Charboneau, U.S. Patent No. 5,551,484. US '485 claims a spoolable composite tube comprising an fluid impervious pressure barrier layer, and a composite fiber layer. The composite fiber layer can comprise helical fibers which are braided with other fibers which corresponds the claimed composite layer. US '485 differs from the claimed invention because it does not claim the energy conductor or the sensor. . Charboneau discloses a lining for pipelines which may include an optical fiber which is in the liner for purposes of monitoring stress or for communication, and which further comprises a capacitance leak detection circuit in the liner. Charboneau further teaches that such linings can comprise an impervious barrier layer. Charboneau teaches that the optical fibers can be connected to a stresses detector to monitor the liner when it is installed in a pipeline. See col. 4, lines 1-61. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated optical fibers for the purpose of monitoring stresses in the tubular member of US '485, motivated by the

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expectation that this would enable pipelines which employed the liners to be monitored for possible problems.

5. Applicant's arguments filed 12/24/08 have been fully considered but they are not persuasive. Applicant argues that Charboneau does not teach that the sensor is coupled to the wall of the tube. However, Charboneau teaches that the leak detection circuit can be disposed in the inner liner which meets the claimed structure. Applicant does not define what is meant by "coupled" to the wall. Charboneau teaches that the fiber is in the liner and the instant claims recite that the wall is made up of the liner, (the fiber reinforced layer). Therefore, Charboneau teaches a sensor coupled to the wall of the liner and the rejection is maintained. .

6. With regard to the 103 rejections, Applicant states that the instant invention and the prior art references were commonly owned at the time the invention was made. Thus, Applicant has successfully invoked 103(c) and removed the references as prior art. It is noted that these references were only available as prior art under 102(e) and were applied as 103 references and that the instant application was filed after 11/29/99.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

The examiner's supervisor Rena Dye may be reached at (571) 272-3186.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

e.m.c